

REMARKS

Status of the Claims

Claims 25-56 are pending in the application. In this response, claims 38, 40, 42, 43, and 45 have been amended and new dependent claims 49-56 have been. Exemplary support for the claim amendments and new dependent claims can be found throughout the specification and claims as originally filed.

Applicants respectfully request the Examiner to reconsider and withdraw the outstanding rejections in view of the foregoing amendments and the following remarks.

Rejection under 35 U.S.C. § 112

Claims 40 and 46 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite.

With regard to claim 40, it is respectfully submitted that claim 40 has been amended to depend from claim 39 not claim 38. Accordingly, there is now sufficient antecedent basis for "the linear pentenenitrile" in claim 40.

Further, with regard to claim 40, it is not clear what the Examiner means by the compounds listed at the bottom of page 4 of the Office Action "are not linear pentenenitrile in the chemical art". Applicants respectfully submit that claim 40 recites: the process according to claim 39, wherein the linear pentenenitrile *contain amounts of other compounds* selected from the group consisting of 2-methyl-3-butenenitrile, 2-methyl-2-butenenitrile, 2-pentenenitrile, valeronitrile, adiponitrile, 2-methylglutaronitrile, 2-ethylsuccinonitrile and butadiene. (emphasis added). Accordingly, as recited in claim 40, the linear pentenenitrile "contains amounts of other compounds selected from the group consisting of" and not "are" the compounds selected from the group consisting of....

With regard to claim 46, Applicants respectfully submit that claim 46 recites: the process according to claim 45, wherein *the 2-methyl-3-butenenitrile subjected to the isomerization is used alone or as a mixture with* 2-methyl-2-butenenitrile, 4-pentenenitrile, 3-pentenenitrile, 2-pentenenitrile, butadiene, adiponitrile, 2-methylglutaronitrile, 2-ethylsuccinonitrile or valeronitrile. (emphasis added). Accordingly, as recited in claim 46, there is no recitation of the linear pentenenitrile "are" the compounds selected from the group consisting of....

In view of at least the foregoing, Applicants respectfully submit that the rejection of claims 40 and 46 should be withdrawn.

Double Patenting

Claims 38-48 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 1 of co-pending Application No. 10/544,953 ("the '953 application").

Applicant believes that the present claims are patentable over claim 1 of the '953 application. However, to facilitate allowable subject matter, a terminal disclaimer over the '953 application will be submitted under separate cover, as appropriate, once allowable subject matter has been agreed upon.

The filing of a Terminal Disclaimer is not to be construed as an admission of the propriety of the rejection on obvious double patenting. *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991).

Claim Objections

Claims 38-48 are objected to as containing non-elected subject matter. In accordance with the Examiner's suggestion, claim 38 has been amended to limit L to the elected subject matter. Accordingly, the claims dependent from claim 38 are also limited to the amended definition of L in claim 38. As such, Applicants respectfully submit that the objection to claims 38-48 should be withdrawn.

Claims 42, 43, and 45 are objected to as containing typographical errors. Claims 42, 43, and 45 have been amended to correct the typographical errors pointed out by the Examiner at page 7 of the Office Action. As such, Applicants respectfully submit that the objection to claims 42, 43, and 45 should be withdrawn.

New Claims

Applicants respectfully submit that new claims 49-56 are directed to the elected subject matter and further limit independent claim 38. Exemplary support for the new dependent claims can be found throughout the specification and claims as originally filed. Applicants further respectfully submit that dependent claims 49-56 are allowable for at least the same reasons as independent claim 38.

Conclusion

Applicants invite the Examiner to contact Applicants' representative at the telephone number listed below if any issues remain in this matter, or if a discussion regarding any portion of the application is desired by the Examiner.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

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